

### **REMARKS**

Claims 61-90 were presented for examination in the present application. The instant amendment cancels claim 62 without prejudice and adds new claim 91. Thus, claims 61 and 63-91 are presented for consideration upon entry of the instant amendment. Claims 61, 90, and 91 are independent.

#### **In the Specification**

The Office Action objected to the specification for various informalities, namely due to the inclusion of references to the claims. The specification has been amended to obviate this objection. Accordingly, reconsideration and withdrawal of the objection to the specification are respectfully requested.

#### **Rejection under §112**

Claims 61-89 were rejected under 35 U.S.C. §112, second paragraph.

With respect to claim 61, the Office Action asserts that there is insufficient antecedent basis for "the conductively heatable melt" recited in line 5.

Applicants respectfully traverse this assertion. Specifically, Applicants submit that "the conductively heatable melt" is a workpiece, which is introduced in the preamble of the claim. Accordingly, the "the conductively heatable melt" recitation meets the requirements under Section 112, second paragraph.

Additionally, the Office Action asserts that the "and/or" recitation of claim 61 is considered indefinite *per se*.

Applicants respectfully disagree. Applicants submit that Office policy is not to employ *per se* rules to make technical rejections. See §2173.02 of the *Manual for*

*Patent Examining Procedure*. Rather, the test for definiteness under 35 U.S.C. §112, second paragraph, is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986). If one skilled in the art is able to ascertain the meaning of the claimed terms 35 U.S.C. §112, second paragraph, is satisfied.

Moreover, Applicants submit that alternative expressions, such as the "and/or" element of claim 61, are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims. See *Ex parte Markush*, 1925 C.D. 126 (Comm'r Pat. 1925).

Applicants respectfully submit that the "melting and/or refining unit" of claim 61 presents no uncertainty or ambiguity and those skilled in the art would understand what is claimed, this particularly true when claim 61 is read in light of the specification, which includes a definition at least at page 10, line 24 of the application as filed.

Nonetheless and merely in the interest of expediting prosecution, claim 61 has been amended to remove the objected language. Similarly, independent claim 90 has been amended to remove the "and/or" recitation.

The Office Action asserted that claim 68 lacks antecedent basis for "the elements" recitation. Applicants note that claim 68 does not include such a recitation, but merely introduces the term "elements". Further, Applicants note that claim 69 includes a recitation of "the elements" and, thus, Applicants assume that the rejection was referring to claim 69 and not claim 68. To that end, claim 69 has been amended to depend from claim 68 in order to ensure proper antecedent basis for "the elements" recitation.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejections under Section 112 to claims 61-89.

Independent claim 61

Independent claim 61, as well as dependent claims 62-67, 72-73, 75-78, and 83-89, were rejected under 35 U.S.C. §103(a) over U.S. Patent No. 2,798,892 to Penberthy et al. (the Penberthy '892 patent) in view of U.S. Patent No. 3,409,725 to Penberthy et al. (the Penberthy '725 patent). Dependent claims 68-71, 74, and 79-82 were rejected under 35 U.S.C. §103(a) over the Penberthy '892 patent and the Penberthy '725 patent in further view of one or more of U.S. Patent No. 4,319,068 to Williamson (Williamson), U.S. Patent No. 4,159,392 to Fineo et al. (Fineo), and U.S. Patent No. 4,468,779 to Gillman (Gillman).

Applicants submit that present claim 61 is not disclosed or suggested by the proposed combination of cited art.

Independent claim 61 has been clarified to recite that the apparatus for reducing the local introduction of heating power comprises "at least one shielding device arranged **in the at least one region of the conductively heatable melt adjacent to the at least one electrode** and a shielding basket having an interior, wherein the **interior of the shielding basket reduces an electric field gradient that occurs in the conductively heatable melt immediately adjacent to the at least one electrode** (emphasis added)".

The Penberthy '892 patent discloses an electrode furnace 30 that is clearly on the exterior of the wall and, thus, is not arranged in the at least one region of the conductively heatable melt as in present claim 61. Moreover, the electrode furnace 30 of the Penberthy '892 patent fails to reduce an electric field gradient that occurs in the conductively heatable melt immediately adjacent to the at least one electrode as now

recited by present claim 61.

The Penberthy '725 patent discloses a refractory sleeve 22, which extends into the glass. However, the refractory sleeve 22 clearly lacks a shielding basket having an interior as now recited by present claim 61. Moreover, and presuming arguendo that the refractory sleeve 22 of Penberthy '725 patent includes an interior, Applicants submit that the refractory sleeve 22 fails to reduce an electric field gradient that occurs in the conductively heatable melt immediately adjacent to the at least one electrode as now recited by present claim 61.

The Office Action fails to assert that any of the remaining art, namely Williamson, Fineo, and Gillman, alone or in combination, cures the aforementioned and other deficiencies of the combination of the Penberthy '892 and '725 patents.

Therefore, independent claim 61, as well as claims dependent claims 63-89, are not disclosed or suggested by the Penberthy '892 and '725 patents alone or in combination with any of the cited art. As such, reconsideration and withdrawal of the rejections to claims 61 and 63-89 are respectfully requested.

Independent claim 90

Independent claim 90 was rejected under 35 U.S.C. §103(a) over the Penberthy '892 patent and the Penberthy '725 patent.

Applicants also submit that present claim 90 is not disclosed or suggested by the proposed combination of cited art.

Independent claim 90 has been clarified to recite, in part, the step of "arranging at least one shielding device and a shielding basket **in the conductively heatable melt so that the at least one electrode passes through an opening in the**

**shielding basket** (emphasis added)".

Again, the Penberthy '892 patent discloses an electrode furnace 30 that is clearly on the exterior of the wall and, thus, is not arranged in the conductively heatable melt as in present claim 90.

Further, Applicants submit that the refractory sleeve 22 of the Penberthy '725 patent, which may extend into the glass, but clearly lacks a shielding basket in the glass much less a shielding basket with opening through which the electrode passes as now recited by present claim 90. In fact, the refractory sleeve 22 of the Penberthy '725 patent is an electrical insulator and, thus, can not reasonably be considered to be a shielding basket.

The Office Action fails to assert that any of the remaining art, namely Williamson, Fineo, and Gillman, alone or in combination, cures the aforementioned and other deficiencies of the combination of the Penberthy '892 and '725 patents.

Therefore, independent claim 90 is not disclosed or suggested by the Penberthy '892 and '725 patents alone or in combination with any of the cited art. As such, reconsideration and withdrawal of the rejections to claim 90 are respectfully requested.

**Independent claim 91**

Claim 91 has been added to point out various aspects of the present application. Applicants specifically point out that new claim 91 is not intended to be limited to the specific mechanisms of patentability previously argued with respect to any prior claims in this or any related applications. Accordingly, Applicants hereby rescind any disclaimer of claim scope and, thus, any prior art for which such a disclaimer was made to avoid may need to be revisited by the Examiner with respect to new claim 91.

Claim 91 is believed to be in condition for allowance. For example, claim 91 recites, in part, "a shielding basket immersed in the conductively heatable melt within the tank, the shielding basket having a basket opening and an interior, the electrode passing through the interior and the basket opening, the basket opening having an inner boundary arranged at a predetermined distance from an outer boundary of the electrode" and "an electrical connection passing through the wall and electrically connecting the shielding basket to an outer region of the electrode".

Applicants submit that the cited art fails to disclose or suggest the shielding basket or electrical connection as recited in claim 91.

Summary

In view of the above, it is respectfully submitted that the present application is in condition for allowance. Such action is solicited.

If for any reason the Examiner feels that consultation with Applicants' attorney would be helpful in the advancement of the prosecution, the Examiner is invited to call the telephone number below.

Respectfully submitted,

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